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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,289	11/13/2003	Volker Boettiger	DE920020042US1	2031
7590 11/09/2005				
The McConnell Law Firm 2115 Saint Mary's Street Raleigh, NC 27608		EXAMINER KIM, AHSHIK		
		ART UNIT 2876 PAPER NUMBER		

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/714,289		BOETTIGER, VOLKER	
	Examiner		Art Unit	
	Ahshik Kim		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/8/05 (*Response*).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/8/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response

1. Receipt is acknowledged of the amendment filed on September 9, 2005. No claims were
5 canceled, amended or newly added. Currently, claims 1-16 remain in the examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10 A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, 9-13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by
15 Levine (US 6,188,309, hereinafter “Levine”).

Re claims 1, 5, 9, 12, and 16, Levine discloses intelligent credit card comprising a processor 62 and memory 66 (see abstract), either of which stores a PIN code entered by the user (col. 4, lines 7+). The card is in deactivated state (see figure 5). When correct PIN is entered, the card changes to its state to “activated state”. The clerk then swipes the card to retrieve the
20 account number (col. 4, lines 23+). The card is activated for a period of time (see step 135 of figure 5 or step 210 of figure 6; col. 4, lines 63+). Re claim 2, the card becomes activated state only after the PIN is successfully verified (col. 4, lines 23+).

Re claims 2 and 10, credit card number, name or other conventional information stored in the credit card can be considered an authorization code.

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Re claim 3, the credit card, in coordination with credit card authorization system, generates authorization code (or a transaction number) to be transmitted (col. 4, lines 51+).

Re claims 4 and 11, the card may use optical transmitting device (col. 1, lines 53-63), wherein in some case, the device may transmit visible beam. The fact that the card is unreadable (col. 1, lines 63+) would be another indication that the card is in de-activated state.

Re claims 6, 7, and 13, the user may perform additional activities via terminal or POS making sure of the purchase amount, etc. while the card is activated.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine (US 6,188,309) in view of Housman (US 3,641,499, hereinafter "Housman").

Levine fails to specifically teach or fairly suggest that the card erases the authorization code from memory if an unsecure situation is detected.

Housman teaches a transaction card which require precise arranging of contacts, which only the owner of the card would know. Incorrect arrangement of contact would result in Otherwise the card is self-destroyed (see abstract; col. 4, lines 40+; col. 4, lines 62+).

In view of Housman's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known self-destruction or self-erasing of

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critical information to the teachings of Levine in order to provide improved security to the card.

Selectively activating of the card as disclosed in Levine provides a certain amount of security.

Without having to enter a PIN personally would be considered another security conscious

characteristics. However, since the PIN code is already stored on the card, loss of card can be

5 potentially more damaging. Unauthorized person may retrieve the PIN number. Accordingly,

incorporating a self-destruction mode would have been an obvious improvement one ordinary

skill in the art could make on the card of Levine to prevent credit card information along with

PIN.

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Response to Arguments

6. Applicant's response filed on September 7, 2005 has been carefully reviewed and considered, but they are not persuasive.

In remark, Applicant argued that Levine discloses transmitting a card number whereas it
15 is PIN being transmitted in the instant application. Examiner acknowledges the difference and the fact that Levine transmits the card number. Applicant claimed "an authorization code", which can be PIN and a lot of other codes. In claim 3 (dependent on claim 1), Applicant kindly lists candidates for "the authorization code"; and they are an authentication code, a personal identification number, a transaction number, or an access code. Examiner is willing to concede
20 that the second example – a personal identification number as what Applicant claims as "PIN". However, a card number, in the Examiner's view, can be interpreted as an authentication code, a transaction number, or an access code. Accordingly, interpretation of Levine as "transmitting an authorization code" is proper.

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Examiner did not equate a PIN and an account number as Applicant argues (see page 6, third paragraph). Examiner's position is that account number is one of authentication code, a transaction number or an access code. In most embodiments, access to the account would be denied without the account number.

5 In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5
10 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Levine and the secondary reference to Housman are directed at a transaction system utilizing a card. As indicated in paragraph 5 above, a particular feature can be adopted by another in that one ordinary skill in the art would contemplate such modification without undue experimentation. Examiner believes that a proper prima-facie case
15 of obviousness has been established.

Applicants remarks have been carefully considered, however, in view of the above, the Examiner has made this Office Action final.

Conclusion

20 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Primary Examiner
Art Unit 2876
November 1, 2005

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